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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,499	10/13/2000	Christopher C. Winslade	0020	1146

7590 09/25/2009
Christopher C. Winslade
500 West Madison St. 34th Floor
Chicago, IL 60661

EXAMINER

RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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09/25/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/687,499	Applicant(s) WINSLADE ET AL.	
	Examiner Yehdega Retta	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This office action is in Request for Continued Examination filed July 21, 2009. Claims 34-39 are amended. Claims 34-39 are currently pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 34 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 34 recites providing a portal containing a plurality of promotions wherein a buyer can search for a promotion from the first party associated with the item for sale *wherein the portal is provided after the offering by a second system of a second party*. The specification however discloses (see fig. 6-9 and related paragraphs) a seller offering an item for sell and a rebate, a coupon or promotion amount is associated with the item and a purchase request from a buyer for the item being offered online is received and a buyer is require to pay a purchase amount corresponding to the sales price amount less the rebate, coupon or promotion amount for item. Also on pages 44-50, the specification teaches a first party offers an item online for sale at a sale price; a coupon of the second party is associated with the item; a purchase request is received from a buyer for the item being offered online and the purchase request is responded to

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by requiring the buyer to pay a purchase amount corresponding to the sales price amount less the coupon amount for the item.

The specification does not provide support for providing the portal after the offering by a second system of a second party **or** the buyer can search for promotion from the first party after the offering by the second system of a second party.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 34, as amended recites, providing a portal containing a plurality of promotions wherein a buyer can search for a promotion from the first party associated with the item for sale *wherein the portal is provided after the offering by a second system of a second part for sale online at the sales price.* It is still unclear if by "providing" means that the portal is provided (submitted, made available) online, after a second system (seller) of an item offers the item online (which means the first party does not provide the promotions until the seller provides the items for sale online. Regarding the purchasing of the item, the claim recites that the second system responds to the online purchase request by collecting from the buyer a purchase amount ...

According to the specification and as indicated by applicant the promotional system may identify the item in the shopping cart and after identifying the sales item the purchase request

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may be responded to. The specification further teaches that a visual rebate element may be displayed for a buyer (the element will typically contain at least one of the rebate parameters) and the visual elements can be banner ads or other advertisements may also direct the buyer to other of the plurality of rebate parameters (see page 38). The claim however does not include any limitation regarding displaying an offer to the user before or after the purchase or selection of an item. Therefore, it is unclear what applicant intends to claim by stating "providing a portal containing promotions after the offering by a second system of the item for sale online".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 34 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Meyer et al. (US 6,915,271).

Regarding claim 34, Meyer teaches offering by a second system of a second party (merchants) items for sale at a sales price amount (see fig. 31-35 col. 39 line 55 to col. 41 line 22); providing a portal containing a plurality of promotions wherein a buyer can search for a promotion from the first party associated with the item for sale, the promotion having a promotion amount (fig. 19-34); receiving, by the second system (merchants), online purchase request from a buyer for at least one item (buy now) (see col. 40 line 64 to col. 41 line 40); responding, by the second system, to the online purchase request by collecting from the buyer a

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purchase amount corresponding to the sales price amount less the promotion amount (see col. 41 line 66 to col. 42 line 25) and electronically communicating, by the second system to the first system, an indication regarding the collection from the buyer of the purchase amount (see col. 40 line 64 to col. 41 line 40, col. 42 line 1-64).

Regarding claim 35, Meyer teaches offering, by a second system of a second party, an item for sale online at a sales price amount (see fig. 33 and 35 also col. 40 line 64 to col. 41 line 40), the item for sale having associated with it, *by the second system of a second party*, a promotion from the first party, the promotion having a promotion amount (see fig. 33 and 35 (\$5 off, Free Beanie Baby with Toy Purchases etc); receiving, by the second system, an online purchase request from a buyer for the item for sale (see col. 40 line 64 to col. 41 line 21 and col. 42 lines 1-36) responding, by the second system, to the online purchase request by collecting from the buyer a purchase amount corresponding to the sales price amount less the promotion amount (see col. 42 lines 1-36); and causing, by the second system, shipment by the second party of the item for sale to the customer (see col. 41 lines 22-40).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer et al. (US 6,915,271) in view of Murphy et al. (US 2002/0052778 A1).

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Regarding claims 36-38, Meyer teaches offering, by a second system of a second party, an item for sale online (see fig. 33 & 35 isavings), wherein the item has been acquired by the second party from the first-party (customer purchasing the items at the second party (promotional site)(see col. 40 line 67 to col. 41 line 2), the item for sale having associated with it a promotion from the first party, the promotion having a promotion amount (see fig. 33 and 35 (\$5 off, Free Beanie Baby with Toy Purchases etc); receiving, by the second system, an online purchase request from a buyer for the item for sale (see col. 40 line 64 to col. 41 line 21 and col. 42 lines 1-36); receiving, by the second system, an online purchase request from a buyer for the item for sale (see col. 40 line 64 to col. 41 line 21 and col. 42 lines 1-36); responding, by the second system, to the online purchase request by collecting from the buyer a purchase amount corresponding to a sales-price amount less the promotion amount (see col. 42 lines 1-36). Meyer does not teach collecting, by the second system, a service fee from the buyer, it is taught in Murphy (see [0015]-[0018]). It would have been obvious to one of ordinary skill in the art at the time of the invention to collect fee from the buyer as in Murphy in order to demonstrate the user's level of interest to the manufacturer or charge for the service provided by the second party.

Claims 36 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer et al. (US 6,915,271) in view of Holda-Fleck (US 5,729,693).

Regarding claims 36 and 39, Meyer teaches offering, by a second system of a second party, an item for sale online (see fig. 33 & 35 isavings), wherein the item has been acquired by the second party from the first-party (customer purchasing the items at the second party (promotional site)(see col. 40 line 67 to col. 41 line 2), the item for sale having associated with it a promotion from the first party, the promotion having a promotion amount (see fig. 33 and 35

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(\$5 off, Free Beanie Baby with Toy Purchases etc); receiving, by the second system, an online purchase request from a buyer for the item for sale (see col. 40 line 64 to col. 41 line 21 and col. 42 lines 1-36); receiving, by the second system, an online purchase request from a buyer for the item for sale (see col. 40 line 64 to col. 41 line 21 and col. 42 lines 1-36); responding, by the second system, to the online purchase request by collecting from the buyer a purchase amount corresponding to a sales-price amount less the promotion amount (see col. 42 lines 1-36). Meyer does not teach collecting, by the second system, a service fee from the buyer, it is taught in Holda-Fleck (see col. 3 lines 23-44). It would have been obvious to one of ordinary skill in the art at the time of the invention to collect fee from the first party, as in Holda-Fleck, in order to charge for the service provided by the second party, as taught in Holda-Fleck.

Response to Arguments

Applicant's arguments filed January 16, 2009 have been fully considered but they are not persuasive.

Regarding claim 34 applicant argues that the Meyer's use of a "buy now" option as part of a displayed incentive is different from "offering, by a second system of a second party, an item for sale online at a sale price amount" ... because, in relied upon "buy now", example any purported portal is provided before, and not after, any purported offering, by a second system of a second party, an item for sale online at a sales price amount. Examiner would like to point out that the claim does not recite providing the portal after ***the user's selection of the item*** for sale or ***after user indication of purchase***. The claim merely recites **offering the item for sale** and providing the portal after the offering. As claimed the purchase request can be requested from the

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offering of the item for sale or from the portal. Applicant also argues that in the presently claimed subject matter the buyer can search for promotions associated with the item for sale, where the item for sale is offered for sale at a sales price amount. Examiner would like to point out that in Meyer's the item are also previously offered for sale at the merchant's website or store, before the promotion is issued by the merchants and provided to the promotional website.

Applicant again argues that claim 34 expressly recites "offering, by a second system of a second party, an item for sale online at a sales price amount". However Examiner would like to point out that because an item is offered on line or the item is available for sale online does not mean an individual must know about the sales price offered for sale. The user has to access the website and the items for sale have to be displayed for the user for the user to know that the item is for sale. In Meyer the items are also offered for sale online and the promotions are also provided online. The promotions also have to be provided after the seller provides the item for sale otherwise the promotions (which are rebates or coupon for products for sale) would not be used since there is no matching item for sale in which the coupon or rebate could be used. Meyer as indicated before teaches that once the user clicks on the "Buy Now" button, to purchase the product with the incentive, the user is directed to a web site for purchasing the product (which is offered for sale from the merchant) from the same site or at a different Web location (see col. 40 line 63 to col. 41 line 21).

Regarding claim 35, as indicated before, Meyer teaches a new pop-up purchase screen is displayed which includes a hyperlinks to all the online merchants and the member is automatically transferred to the online store to purchase the goods or services (see col. 41 lines

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7-40). Therefore, the online purchase request is received by the second system from the buyer directly or indirectly.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/
Primary Examiner, Art Unit 3622